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KENYON & KENYON  
1500 K STREET, N.W., SUITE 700  
WASHINGTON, DC 20005

EXAMINER
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HUISMAN, DAVID J

ART UNIT	PAPER NUMBER
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2183

DATE MAILED: 12/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Notice of Non-Compliant Amendment (37 CFR 1.121)**

The amendment document filed on 21 October 2003 is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121, as amended on June 30, 2003 (see 68 *Fed Reg.* 38611, Jun. 30, 2003). In order for the amendment document to be compliant, correction of the following item(s) is required. **Only the corrected section of the non-compliant amendment document must be resubmitted (in its entirety), e.g., the entire "Amendments to the claims" section of applicant's amendment document must be resubmitted.** 37 CFR 1.121(h).

THE FOLLOWING CHECKED (X) ITEM(S) CAUSE THE AMENDMENT DOCUMENT TO BE NON-COMPLIANT:

- ☐ 1. Amendments to the specification:
- ☐ A. Amended paragraph(s) do not include markings.
  - ☐ B. New paragraph(s) should not be underlined.
  - ☐ C. Other: \_\_\_\_\_
- ☐ 2. Abstract:
- ☐ A. Not presented on a separate sheet. 37 CFR 1.72.
  - ☐ B. Other: \_\_\_\_\_
- ☐ 3. Amendments to the drawings: \_\_\_\_\_
- ☒ 4. Amendments to the claims:
- ☐ A. A complete listing of all of the claims is not present.
  - ☐ B. The listing of claims does not include the text of all claims (including withdrawn claims)
  - ☐ C. Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified.
  - ☐ D. The claims of this amendment paper have not been presented in ascending numerical order.
  - ☒ E. Other: see attached sheet

For further explanation of the amendment format required by 37 CFR 1.121, see MPEP Sec. 714 and the USPTO website at <http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/officeflyer.pdf>.

If the non-compliant amendment is a **PRELIMINARY AMENDMENT**, applicant is given ONE MONTH from the mail date of this letter to supply the corrected section which complies with 37 CFR 1.121. Failure to comply with 37 CFR 1.121 will result in non-entry of the preliminary amendment and examination on the merits will commence without consideration of the proposed changes in the preliminary amendment(s). This notice is not an action under 35 U.S.C. 132, and **this ONE MONTH time limit is not extendable.**

If the non-compliant amendment is a reply to a **NON-FINAL OFFICE ACTION (including a submission for an RCE)**, and since the amendment appears to be a *bona fide* attempt to be a reply (37 CFR 1.135(c)), applicant is given a TIME PERIOD of ONE MONTH from the mailing of this notice within which to re-submit the corrected section which complies with 37 CFR 1.121 in order to avoid abandonment. **EXTENSIONS OF THIS TIME PERIOD ARE AVAILABLE UNDER 37 CFR 1.136(a).**

If the amendment is a reply to a **FINAL REJECTION**, this form may be an attachment to an Advisory Action. **The period for response to a final rejection continues to run from the date set in the final rejection,** and is not affected by the non-compliant status of the amendment.

Art Unit: 2183

1. The applicant has used the status identifier “(Previously Amended)” for multiple claims. However, the correct status identifier is “(Previously Presented)”. In addition, the applicant has withdrawn claim 3, which had been previously cancelled. Finally, withdrawing a claim and deleting all of the text (claims 3 and 16) results in the claim still existing within the application. According to the attached flyer, “Withdrawn” signifies a claim still in the application, but in non-elected status. This is used when a restriction has been made and the claim in question does not fall in the elected group. Applicant should be using the “(Canceled)” identifier and showing no claim text.


### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Huisman whose telephone number is (703) 305-7811. The examiner can normally be reached on Monday-Friday (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Eddie Chan can be reached on (703) 305-9712. The fax phone number for the organization where this application or proceeding is assigned is (703) 746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

DJH  
David J. Huisman  
December 9, 2003

  
EDDIE CHAN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100

<b>REVISED AMENDMENT PRACTICE: 37 CFR 1.121 CHANGED COMPLIANCE IS MANDATORY - Effective Date: July 30, 2003</b>
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All amendments filed on or after the effective date noted above must comply with revised 37 CFR 1.121. See Final Rule: **Changes To Implement Electronic Maintenance of Official Patent Application Records** (68 Fed. Reg. 38611 (June 30, 2003)), posted on the Office's website at: <http://www.uspto.gov/web/patents/ifw/> with related information. The amendment practice set forth in revised 37 CFR 1.121, and described below, replaces the voluntary revised amendment format available to applicants since February 2003. **NOTE: STRICT COMPLIANCE WITH THE REVISED 37 CFR 1.121 IS REQUIRED AS OF THE EFFECTIVE DATE (July 30, 2003).** The Office will notify applicants of amendments that are not accepted because they do not comply with revised 37 CFR 1.121 via a Notice of Non-Compliant Amendment. See MPEP 714.03 (Rev. 1, Feb. 2003). The non-compliant section(s) will have to be corrected and the entire corrected section(s) resubmitted within a set period.

***Bold underlined italic font has been used below to highlight the major differences between the revised 37 CFR 1.121 and the voluntary revised amendment format that applicants could use since February, 2003.***

Note: The amendment practice for reissues and reexamination proceedings, except for drawings, has not changed.

### **REVISED AMENDMENT PRACTICE**

#### **I. Begin each section of an amendment document on a separate sheet:**

Each section of an amendment document (e.g., Specification Amendments, Claim Amendments, Drawing Amendments, and Remarks) must begin on a separate sheet. Starting each separate section on a new page will facilitate the process of separately indexing and scanning each section of an amendment document for placement in an image file wrapper.

#### **II. Two versions of amended part(s) no longer required:**

37 CFR 1.121 has been revised to **no longer require** two versions (a clean version and a marked up version) of each replacement paragraph or section, or amended claim. Note, however, the requirements for a clean version and a marked up version for **substitute specifications** under 37 CFR 1.125 have been retained.

#### **A) Amendments to the claims:**

Each amendment document that includes a change to an existing claim, cancellation of a claim or submission of a new claim, **must include a complete listing** of all claims in the application. After each claim number in the listing, the status must be indicated in a parenthetical expression, and the **text of each pending claim** (with markings to show **current** changes) must be presented. The claims in the listing will replace all prior claims in the application.

- (1) The current status of all of the claims in the application, including any previously canceled, not entered or withdrawn claims, must be given in a parenthetical expression following the claim number using only one of the following seven status identifiers: (original), (currently amended), (canceled), (withdrawn), (new), **(previously presented) and (not entered)**. The text of all pending claims, **including withdrawn claims**, must be submitted each time any claim is amended. Canceled **and not entered** claims must be indicated by only the claim number and status, without presenting the text of the claims.
- (2) The text of all claims **being currently amended** must be presented in the claim listing with markings to indicate the changes that have been made relative to the immediate prior version. The changes in any amended claim must be shown by underlining (for added matter) or strikethrough (for deleted matter) with 2 exceptions: (1) for **deletion of five characters or fewer, double brackets may be used (e.g., [[eroor]])**; and (2) if **strikethrough cannot be easily perceived (e.g., deletion of the number "4" or certain punctuation marks), double brackets must be used (e.g., [[4]])**. **As an alternative to using double brackets, however, extra portions of text may be included before and after text being deleted, all in strikethrough, followed by including and underlining the extra text with the desired change (e.g., ~~number 4~~ as number 14 as).** An accompanying clean version is not required and should not be presented. Only claims of the status "currently amended," and "withdrawn" that are being amended, may include markings.
- (3) The text of pending claims **not being currently amended, including withdrawn claims**, must be presented in the claim listing in clean version, i.e., without any markings. Any claim text presented in clean version will constitute an assertion that it has not been changed relative to the immediate prior version except to omit markings that may have been present in the immediate prior version of the claims.

- (4) A claim being canceled must be listed in the claim listing with the status identifier “canceled”; the text of the claim must not be presented. Providing an instruction to cancel is optional.
- (5) Any claims added by amendment must be presented in the claim listing with the status identifier “(new)”; the text of the claim must not be underlined.
- (6) All of the claims in the claim listing must be presented in ascending numerical order. Consecutive canceled, or not entered, claims may be aggregated into one statement (e.g., Claims 1 – 5 (canceled)).

**Example of listing of claims (use of the word “claim” before the claim number is optional):**

Claims 1-5 (canceled)

Claim 6 (previously presented): A bucket with a handle.

Claim 7 (withdrawn): A handle comprising an elongated wire.

Claim 8 (withdrawn): The handle of claim 7 further comprising a plastic grip.

Claim 9 (currently amended): A bucket with a green blue handle.

Claim 10 (original): The bucket of claim 9 wherein the handle is made of wood.

Claim 11 (canceled)

Claim 12 (not entered)

Claim 13 (new): A bucket with plastic sides and bottom.

**B) Amendments to the specification:**

Amendments to the specification, including the abstract, must be made by presenting a replacement paragraph or section or abstract marked up to show changes made relative to the immediate prior version. An accompanying clean version is not required and should not be presented. Newly added paragraphs or sections, including a new abstract (instead of a replacement abstract), must not be underlined. A replacement or new abstract must be submitted on a separate sheet, 37 CFR 1.72. If a substitute specification is being submitted to incorporate extensive amendments, both a clean version (which will be entered) and a marked up version must be submitted as per 37 CFR 1.125.

The changes in any replacement paragraph or section, or substitute specification must be shown by underlining (for added matter) or strikethrough (for deleted matter) with 2 exceptions: (1) for deletion of five characters or fewer, double brackets may be used (e.g., [[eroor]]); and (2) if strikethrough cannot be easily perceived (e.g., deletion of the number “4” or certain punctuation marks), double brackets must be used (e.g., [[4]]). As an alternative to using double brackets, however, extra portions of text may be included before and after text being deleted, all in strikethrough, followed by including and underlining the extra text with the desired change (e.g., number 4 as number 14 as)

**C) Amendments to drawing figures:**

Drawing changes must be made by presenting replacement figures which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments, or remarks, section of the amendment, and may be accompanied by a marked-up copy of one or more of the figures being amended, with annotations. Any replacement drawing sheet must be identified in the top margin as “Replacement Sheet” and include all of the figures appearing on the immediate prior version of the sheet, even though only one figure may be amended. Any marked-up (annotated) copy showing changes must be labeled “Annotated Marked-up Drawings” and accompany the replacement sheet in the amendment (e.g., as an appendix). The figure or figure number of the amended drawing(s) must **not** be labeled as “amended.” If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Questions regarding the submission of amendments pursuant to the revised practice set forth in this flyer should be directed to: Elizabeth Dougherty or Gena Jones, Legal Advisors, or Joe Narcavage, Senior Special Projects Examiner, Office of Patent Legal Administration, by e-mail to [patentpractice@uspto.gov](mailto:patentpractice@uspto.gov) or by phone at (703) 305-1616.

in the margin of amendments to the specification or claims. Paragraph (b)(2)(ii) has also been revised to eliminate the requirement to provide a clean version of the replacement section. Examples of typical amendments in the revised practice will be available on the Office's Internet Web site (<http://www.uspto.gov>).

Amendments to the abstract of the disclosure should be included in that portion of applicant's amendment document which presents amendments to the specification. Where the amendments to the abstract are minor in nature, *i.e.*, purely grammatical in nature or a limited number of additions or deletions of subject matter are presented, the abstract should be provided as a marked-up version using strike-through and underlining as the methods to show all changes relative to the immediate prior version. Where the abstract is being substantially rewritten and the amended abstract bears little or no resemblance to the previously filed version of the abstract, a new (substitute) abstract may be provided in clean form accompanied by an instruction for the cancellation of the previous version of the abstract. The text of the new abstract must not be underlined. It would be counterproductive for applicant to prepare and provide an abstract so riddled with strike-through and underlining that its meaning and language are obscured from view and comprehension. Whether supplying a marked-up version of a previous abstract or a clean form new abstract, the abstract must still comply with § 1.72(b) requirements regarding length and placement of the abstract on a separate sheet of paper.

Paragraph (b)(3) has been rewritten to reflect a concurrent revision to § 1.125. Although the requirement for a clean form, or version without markings, of a replacement paragraph or section of the specification has been eliminated, the Office maintains the need for a clean form and a marked-up version of a substitute specification. Since substitute specifications generally include many changes, the clean version will assist the examiner to view the substitute specification without distractions from the markings. The marked-up version will assist the examiner in readily ascertaining those changes being made and to alert the examiner to the presence of any new matter. Amendment by substitute specification is permissible where, as set forth in § 1.121(b)(3)(i), an instruction to replace the specification is submitted and, as set forth in § 1.121(b)(3)(ii), the substitute specification is provided in compliance

with §§ 1.125(b) and (c). Section 1.125(b) continues to require that a substitute specification be accompanied by a statement that it includes no new matter. Section 1.125(c) now requires that two versions of the substitute specification be provided. One version must be submitted with markings showing all changes (strike-through, or in some cases double brackets, indicating subject matter being deleted and underlining indicating subject matter being added) relative to the immediate prior version of the specification of record. An accompanying clean version (without markings) must also be supplied.

Strike-through and underlining features are available in most, if not all, commercially available word processing systems. Often times these features are located and activated through a "format" menu, which allows the user to create text, which is struck through or underlined, or highlight text already presented. In the latter case, previously presented text may be selected and strike-through or underlining engaged such that the text is marked in the desired fashion. Additionally, some word processing systems offer editorial tools that permit a user to automatically "track changes" made when editing a document. These editorial tools frequently use strike-through as the manner in which to indicate deleted subject matter and underlining as the manner in which to indicate added subject matter. To clearly identify a line or a section of a document in which changes have been made, these editorial tools may place a vertical line in the left or right margin of the document directly adjacent to the line or section of text in which the changes occur. The presence of such vertical lines in the left or right margin of a replacement paragraph or section of the specification or a marked-up version of a substitute specification is acceptable.

Deleted subject matter may also be indicated in some circumstances by double brackets placed at the beginning and the end of the deleted text. Double brackets must be used if the deleted text would not be easily perceived using strike-through. For example, changing "4 corners" to "three corners" should be indicated by "*three* [[4]] corners" rather than "*three*4 corners" (the strike-through being obscured by the horizontal line in the "4"). Double brackets may also be used to indicate the deletion of five or fewer consecutive characters. Alternatively, the use of strike-through and/or underlining to show the deletion and/or addition of punctuation marks or difficult to perceive characters may, in the

replacement paragraph or rewritten claim, encompass portions of text before and after the punctuation marks or characters. Examples of typical amendments in the revised format will be available on the Office's Internet Web site (<http://www.uspto.gov>).

The prior requirement made in §§ 1.121(b)(1)(ii) and (b)(2)(ii) to provide a clean form, or version without markings, of a replacement paragraph or section to the specification has been eliminated.

Paragraph (b)(4) remains unchanged.

New § 1.121(b)(5) has been added to provide that once a paragraph, section, or specification is amended in a first amendment document, re-presentation of the amended material in subsequent amendment documents is not necessary unless it is amended again or a substitute specification is provided.

Paragraphs (c)(1) through (c)(3) have been replaced with revised §§ 1.121(c) and (c)(1) through (c)(5). Paragraph (c) as revised provides for a total rewriting of a claim each time the claim is amended, including markings to show the changes being made relative to the immediate prior version of the claim, except when the claim is being canceled. Section 1.121(c) also requires submitting a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, and the status of each and every claim in every amendment document that includes an amendment to the claims. This listing, if entered, replaces all prior versions of the claims in the application. Inclusion of the claim status is required for each claim in each claim listing and must be indicated in a parenthetical expression following the claim number. The status of all claims in the application, even those previously canceled or withdrawn, must be indicated in the claim listing.

The status of each claim included in the claim listing must be described by one of the following seven defined identifiers in parentheses after the claim number:

(Original): Claim filed with the application

(Currently amended): Claim being amended in the current amendment document

(Canceled): Claim deleted from the application.

(Withdrawn): Claim still in the application, but in a non-elected status.

(Previously presented): Claim added or amended in an earlier amendment document.

(New): Claim being added in the current amendment document.